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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,751	12/21/2001	Kenneth L. Levy	P0530	2711

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EXAMINER	
BROWN, ALVIN L	
ART UNIT	PAPER NUMBER
3622	
MAIL DATE	DELIVERY MODE
10/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/028,751	LEVY ET AL.	
	Examiner	Art Unit	
	ALVIN L. BROWN	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-7,9-12 and 22-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-7,9-12 and 22-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *07/14/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-4, 8, 13-21 have been canceled. Claims 5-7, 9-12, 22-25 have been examined.

Response to Amendment

2. The amendment filed on 07/09/2008 is insufficient to overcome the prior art rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 5, 7, 10-12, 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Abecassis (6,553,178 B2).

As per claim 5, Abecassis discloses a method of video content delivery, including providing entertainment video content having a fingerprinted or digitally watermarked promotional message therein, the promotional message interrupting and separating the entertainment video content into first and second portions, and sensing the fingerprint or watermark of the promotional message when the promotional message is rendered at a user device, wherein if the promotional message is skipped over to more rapidly reach the second portion of the entertainment video content, the failed sensing of the fingerprint or watermark serves to change the terms under which the entertainment video content is provided (column 6, lines 25-34; column 44, line 46 –

column 45, line 9; column 39, line 53 - column 40, line 16; column 7, line 47- column 8, line 15; column 9, lines 2-14).

As per claim 7, Abecassis discloses a method of entertainment video content delivery, including providing entertainment video content having plural fingerprinted or digitally watermarked promotional messages therein, and sensing same as the entertainment video content is rendered at a user device, wherein sensing of one or more of said fingerprinted or watermarked messages entitles a user to access other content or capabilities as a reward for the user having viewed one or more promotional messages in the entertainment video content (abstract; column 45, line 1-29; column 46, line 42-50; column 48, lines 15-50).

As per claim 10, Abecassis discloses a method comprising:

rendering video entertainment content to a user, the video entertainment content including promotional content integrated therein, rather than interrupting same (column 44, lines 46-67; column 45, lines 10-18);

receiving a signal from a user interaction device indicating selection of the promotional content during the rendering of said video entertainment content (column 45, lines 10-18);

in response to said selection, providing to said user additional promotional information related to the selected promotional content (column 45, lines 30- 57); and

providing the user a reward for receiving said additional promotional information (column 48, lines 15-21).

As per claim 11, Abecassis further discloses the reward includes promotional points redeemable for premiums (column 48, lines 37- 50).

As per claim 12, Abecassis further discloses additional promotional information is provided to the user through a process that makes use of fingerprint or digital watermark information conveyed by said video content (column 45, lines 10-29; column 7, line 47- column 8, line 15; column 9, lines 2-14).

As per claim 22, Abecassis further discloses presenting linking options to the user, and receiving a user selection of one of said options (column 46, lines 1-15; column 48, lines 60-67).

As per claim 23, Abecassis further discloses conveying data relating to the linking options by one of the group consisting of: digital watermarking, Multicast IP, vertical blanking interval signaling, and file header data (column 1, lines 44-50).

As per claim 24, Abecassis further discloses the reward comprises a discount for a product promoted by said promotional content (column 48, lines 42-50).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (6,553,178 B2) in view of Itoh et al. (2003/0206632 A1).

As per claim 6, Abecassis further discloses a viewer's ability to skip advertisements by using the skip key and crediting/debiting the user's account based on viewing of selected advertisement (column 39, line 33- column 40, line 9).

Abecassis does not explicitly disclose the changed terms include assessing a charge for skipping the promotional message.

However, Itoh teaches a charge for skipping commercials (paragraph [0059, 0060]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Itoh's charge for skipping commercials to Abecassis video with watermark and ability to skip advertisements. One would be motivated to do this in order to track consumers' exposure to advertisers' promotional material which serve to justify their investment.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (6,553,178 B2) in view of Goldhaber et al. (5,794,210).

As per claim 9, Abecassis discloses a method comprising:

receiving video content at a user device without paying a proprietor for the content rendering the video content for viewing (column 4, lines 30-35; column 48, lines 37-41).

Abecassis further discloses the detection of the fingerprint or digital watermark during rendering wherein consideration for the viewing is triggered by the viewing itself, rather than in advance of the viewing (abstract; column 45, line 1-29; column 46, line 42-50; column 48, lines 15-50).

Abecassis does not explicitly disclose a payment to said proprietor.

However, Goldhaber teaches content supported by revenue received from advertiser (column 1, line 50- column 2, line 12; column 8, lines 59-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Goldhaber's payment to content proprietor to Abecassis video with watermark. One would be motivated to do this in order to provide service providers with additional means of earning revenue.

5. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (6,553,178 B2) in view of Jones et al. (5,978,013).

As per claim 25, Abecassis further discloses displaying an on-screen signal with the rendered entertainment content, to indicate that an opportunity exists for the user to earn credit by viewing additional information (figure 12A and 12B).

Abecassis does not explicitly disclose on-screen display to indicate to the user that credits can be earned by viewing additional information.

However, Jones teaches an on-screen display to indicate to the user that credits can be earned by viewing additional information (column 2, lines 48-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Jones' offer to earn credits to Abecassis on-screen notification. One would be motivated to do this in order to distribute promotional material to users and provide wider exposure to advertisers.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Please see the additions of Goldhaber and Jones to the rejection of independent and dependent claims above. Examiner also notes the following:

On page 5 of the Applicant's Remarks dated July 09, 2008, Applicant states that "Abecassis suffers in that there is no way to endure that the consumer actually views a selected promotional video." Examiner respectfully disagrees since Abecassis discloses "A random access pointcast architecture provides the means for a viewer to select and retrieve a desired advertisement, and provides the means to compensate the viewer for the verified apparent viewing of the advertisement. Such a system provides a closer match between the viewer's interest and the object of the advertisement, and further increases the potential purchase by the viewer of the promoted product or service, than a system directed to an inclusion/exclusion determination" (column 45, lines 1-9).

Applicant further argues that "Abecassis is not understood to teach a method *to skip advertisement which changes the cost of the video downloaded by the viewer"* Examiner respectfully disagrees since Abecassis discloses "The skip and replay keys provide the viewer access to the functions that utilize the capabilities that are made possible by a video segment map. During the viewing of a video, pressing the skip key causes the automatic skipping of the further transmission of the current segment, and the instantaneous transmission of the next logical segment" (column 39, lines 53-58); "A random access pointcast architecture provides the means for a viewer to select and retrieve a desired advertisement, and provides the means to compensate the viewer for

the verified apparent viewing of the advertisement. Such a system provides a closer match between the viewer's interest and the object of the advertisement, and further increases the potential purchase by the viewer of the promoted product or service, than a system directed to an inclusion/exclusion determination" (column 45, lines 1-9); "Compensation for the viewing of an advertisement may take many forms. For example, a viewer may be compensated or rewarded with the transmission of a desirable motion picture not otherwise available free of charge or at a discount" (column 48, lines 36-41).

Please also note that Abecassis teaches that a user is compensated for the verified viewing of the advertisement as in a television programming.

Applicant further argues "that watermark/fingerprint is sensed from the video content as it is rendered at the user device." Examiner respectfully disagrees since Abecassis discloses a method of entertainment video content delivery, including providing entertainment video content having plural fingerprinted or digitally watermarked promotional messages therein, and sensing same as the entertainment video content is rendered at a user device, wherein sensing of one or more of said fingerprinted or watermarked messages entitles a user to access other content or capabilities as a reward for the user having viewed one or more promotional messages in the entertainment video content (abstract; column 45, line 1-29; column 46, line 42-50; column 48, lines 15-50).

Applicant further argues that "no compensation is provided to the proprietor after the free content is provided." Examiner disagrees since Abecassis discloses a method comprising receiving video content at a user device without paying a proprietor for the

content rendering the video content for viewing (column 4, lines 30-35; column 48, lines 37-41).

Examiner further notes that Abecassis discloses the detection of the fingerprint or digital watermark during rendering wherein consideration for the viewing is triggered by the viewing itself, rather than in advance of the viewing (abstract; column 45, line 1-29; column 46, line 42-50; column 48, lines 15-50).

Abecassis does not explicitly disclose a payment to said proprietor.

However, Goldhaber teaches content supported by revenue received from advertiser (column 1, line 50- column 2, line 12; column 8, lines 59-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Goldhaber's payment to content proprietor to Abecassis video with watermark. One would be motivated to do this in order to provide service providers with additional means of earning revenue.

Examiner respectfully notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Note, as stated above, that the claims can be interpreted in different ways because of the broad disclosure of the claims.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller,* 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN L. BROWN whose telephone number is (571)270-5109. The examiner can normally be reached on Monday - Thursday 7:30 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571 272 6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALB

/Arthur Duran/
Primary Examiner, Art Unit 3622
10/8/2008